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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,045	05/01/2001	Philip Ted Kortum	8285/431	5221
757	7590	12/07/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/847,045

**Applicant(s)**

KORTUM, PHILIP TED

**Examiner**

Igor Borissov

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Amendment received on 9/03/2004 is acknowledged and entered. Claims 1, 8 and 16 have been amended. Claims 1, 3-8, 10-16 and 18-21 are currently pending in the application.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1, 3-8 and 10-15 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claim 1**. The phrase: "... *at most one* instruction manual...", and wherein all of the *at least one* instruction manual..." is confusing, because the term "*at most one*" implies one instruction manual or no instruction manual at all; while the term "*at least one*" implies one instruction manual or more.

As per **claim 8**. The phrase: "... a *plurality* of instruction manuals including *at most one* instruction manual..." is confusing, because the term "a plurality" implies more than one, while the term "at most one" implies no more than one.

The remaining claims are rejected as being dependent on the independent claims.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 5-7, 8, 12-15, 16 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the “SBC global network DSL: Customer Self Install” (Document) in view of Klees (US 5,283,661).**

The Document, which appears to be published on August, 2000, teaches customer self installation DSL kit and method of installing thereof, comprising:

*Independent Claims.*

As per **claim 1**,

- a digital subscriber line modem (page 4; last §);
- at least one digital subscriber line filter (page 1; 3<sup>rd</sup> §);
- a computer-readable medium containing a computer-readable software code (page 9; 2<sup>nd</sup> §).

Furthermore, Document teaches a consumer computer manufacturer's Owner's Guide and computer's Operating System on installation media (CD or diskettes) (page 9; 2<sup>nd</sup> §).

However, Document does not specifically teach that said instruction manual (Owner's Guide) is included in the kit.

Klees teaches an apparatus for assisting in the installation of a facsimile machine, wherein the indication is provided that currently, most facsimile equipment come with a manual that has instructions for installation and setup of the machine (C. 1, L. 14-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Document to include that said instruction manual is included in the kit, as disclosed in Klees, because it would advantageously allow to provide the customer with necessary diagram and descriptions of the successive installation steps, thereby simplify the installation process for the customer.

Furthermore, Document teaches:

As per **claim 8**,

- a network card (page 4; last §);
- a digital subscriber line modem (page 4; last §);

Art Unit: 3629

- at least one digital subscriber line filter (page 1; 3<sup>rd</sup> §);
- a computer-readable medium containing a computer-readable connection software code (page 9; 2<sup>nd</sup> §).

Furthermore, Document teaches a consumer computer manufacturer's Owner's Guide and computer's Operating System on installation media (CD or diskettes) (page 9; 2<sup>nd</sup> §).

However, Document does not specifically teach that said instruction manual (Owner's Guide) is included in the kit.

Klees teaches an apparatus for assisting in the installation of a facsimile machine, wherein the indication is provided that currently, most facsimile equipment come with a manual that has instructions for installation and setup of the machine (C. 1, L. 14-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Document to include that said instruction manual is included in the kit, as disclosed in Klees, because it would advantageously allow to provide the customer with necessary diagram and descriptions of the successive installation steps, thereby simplify the installation process for the customer.

As per **claim 16**, Document teaches:

- a network card
- a digital subscriber line modem (page 4; last §);
- at least one digital subscriber line filter (page 1; 3<sup>rd</sup> §);
- a computer-readable medium containing a computer-readable connection software code (page 9; 2<sup>nd</sup> §).

Furthermore, Document teaches a consumer computer manufacturer's Owner's Guide and computer's Operating System on installation media (CD or diskettes) (page 9; 2<sup>nd</sup> §); and instruction regarding internet service provider software (page 3, 2<sup>nd</sup> and 3<sup>rd</sup> §§).

However, Document does not specifically teach that said instruction manual (Owner's Guide) is included in the kit.

Art Unit: 3629

Klees teaches an apparatus for assisting in the installation of a facsimile machine, wherein the indication is provided that currently, most facsimile equipment come with a manual that has instructions for installation and setup of the machine (C. 1, L. 14-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Document to include that said instruction manual is included in the kit, as disclosed in Klees, because it would advantageously allow to provide the customer with necessary diagram and descriptions of the successive installation steps, thereby simplify the installation process for the customer.

*Dependent Claims.*

As per **claims 5 and 13**, said kit, wherein the instruction manual provides a point of contact telephone number associated with said kid; said kid including the digital subscriber line modem (page 3, 6<sup>th</sup> §; page 5, 6<sup>th</sup> §; page 4; last §).

As per **claims 6 and 14**, said kit, wherein the instruction manual provides a point of contact telephone number associated with said kid; said kid including the digital line filter (page 3, 6<sup>th</sup> §; page 5, 6<sup>th</sup> §; page 1, 3<sup>rd</sup> §).

As per **claims 7, 15 and 20**, said kit, wherein the instruction manual provides a point of contact telephone number associated with said kid; said kid including the description of computer-readable connection software code (page 9; 2<sup>nd</sup> §).

As per **claims 21**, said kit including an instruction manual (See reasoning applied to **claim 1**).

**Dependent claims 3-4, 10-11 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Document in view of Klees and further in view of Official Notice.**

As per **claims 3-4, 10-11 and 18-19**, Document in view of Klees teach all the limitations of **claims 3-4, 10-11 and 18-19**, except a container, which contains said kit and manual.

Art Unit: 3629

Official notice is taken that it is well known to provide goods ordered by customers in shipping containers.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Document to include the container, because the container would advantageously protect the contents of the kit against damage or from being lost during shipment.

***Examiner's Note***

A "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

***Response to Arguments.***

Applicant's arguments with respect to **claims 1, 3-8, 10-16 and 18-21** have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

US patent 6,543,113 B1 to Khurana, discloses a kit for tooling components, said kit including an instruction manual for using the components of the kit (C. 4, L. 25-27).

Publication: Communicator for Pocket PCs; Installation and User Guide; describes the user manual, said manual including descriptions how to connect to the Internet and download files (pages 3-4).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 872-9306**

[Official communications; including After Final  
communications labeled "Box AF"]



Art Unit: 3629

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

Igor Borissov  
Patent Examiner  
Art Unit 3629

A handwritten signature in black ink, appearing to be 'Igor Borissov', written over a large, loopy oval shape.

IB

12/02/2004